



Application No. 10/055,255
Group Art Unit: 3627

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS**

In re the application of:)	
)	Group Art Unit: 3627
HAMILTON, Robert Douglas)	
)	Examiner: Andrew J. Fischer
Application No: 10/055,255)	
)	Attorney Docket: 92833-1
Filed: January 24, 2002)	

For: METHOD AND SYSTEM FOR PROVIDING AND CONTROLLING DELIVERY
OF CONTENT ON-DEMAND OVER A CABLE TELEVISION NETWORK AND
A DATA NETWORK

APPELLANT'S BRIEF UNDER 37 C.F.R. 1.192

The Assistant Commissioner of Patents
Washington, D.C. 20231
U.S.A.

Dear Sir or Madam:

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GROUP 3600

The following is the Appellant's Brief, submitted in triplicate and under the provisions
of 37 C.F.R. 1.192. The fee of \$340 required by 37 C.F.R. 1.17(c) is enclosed.

Real Party in Interest

The real party in interest is the assignee of record, i.e. SHAW COMMUNICATIONS
INC., Suite 900, 630 - 3rd Avenue SW, Calgary, Alberta, Canada, T2P 4L4.

Related Appeals and Interferences

There are no related appeals or interferences that will directly affect, be directly
affected by, or have a bearing on the present appeal.

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Status of Claims

The present appeal is directed to pending claims 1-38 in this application. Claims 1-27 have been twice rejected. Claims 33-38 are withdrawn from consideration.

Status of Amendments

Claims 1, 2, and 26 have been amended by way of amendment filed concurrently herewith. A copy of the claims as amended is attached.

Summary of the Invention

In accordance with an aspect of the present invention, content on-demand is delivered by way of cable television network. Provision of such content is controlled over a data network (Fig. 2, 20). A user interface at a conventional computing device (Fig. 2, 12) may be used to order content and to control its delivery and playing. Commands from the computing device (Fig. 2, 12) may be provided by way of data network (Fig. 2, 20) to a network interconnected server (Fig. 2, 22). The server under software control causes a media receiver (Fig. 2, 52) at the customer premises to be remotely tuned to receive content on-demand and content on-demand to be played, as requested by the computing device (Fig. 2, 12). Advantageously, the media receiver (Fig. 2, 52) may be a conventional set-top box (Fig. 2, 80) that may be tuned remotely in response to a customer placing an on-demand order. The computing device (12) may be a conventional home computing device. As such, no additional hardware or hardware upgrades need be provided by the cable network operator to the customer to provide the content on-demand.

In accordance with an aspect of the present invention, and from the perspective of a content provider, there is provided a method of providing content on-demand to a customer having at least one tunable media receiver (Fig. 2, 52) interconnected with a cable television network (Fig. 2, 50), and a computing device separate (Fig. 2, 12) from the media receiver (Fig. 2, 52) and in communication with a data network (Fig.

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2, 20). The method includes receiving from the computing device (Fig. 2, 12) over the data network (Fig. 2, 20), an indicator of an identity of the customer and a request for a media stream; remotely tuning one of the at least one tunable media receivers (Fig. 2, 52) over the cable television network (Fig. 2, 50), to receive the content over the cable television network on a tuned channel that is not otherwise tunable by the customer; and providing the content over the cable television network (Fig. 2, 50) for receipt and presentation by the media receiver (Fig. 2, 52), when tuned to the tuned channel.

Issues

The issues under appeal are whether the Examiner erred in:

- A. Objecting to the drawings under 37 CFR 1.83(a) as not disclosing all the features as claimed in claims 13, 21, and 22;
- B. Rejecting claims 1-27 under 35 USC 112 as indefinite;
- C. Rejecting claims 1-9, 11-32 under 35 USC 102 as being anticipated by US Patent No. 6,078,961 to Mourad et al. ("Mourad");
- D. Rejecting claims 1-9, 11-32 under 35 USC 102 as being anticipated by US Patent No. 5,716,315 to Handelman ("Handelman");
- E. Rejecting claims 1-9, 11-32 under 35 USC 103 as being obvious in view of Mourad and US Patent No. 5,583,561 to Baker et al. ("Baker"); and
- F. Rejecting claim 10 under 35 USC 103(a) as being obvious over Mourad in view of US Patent No. 6,279,158 to Geile ("Geile")

Grouping of claims

Each of claim 1-33 stands and falls on its own.

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Argument

A. Objection to the drawings under 37 CFR 1.83(a) as not disclosing all the features as claimed in claims 13, 21, and 22;

The Examiner has objected to the Drawings under 37 CFR 1.83(a) taking the position that the drawings do not show all features of the invention as claimed in relation to three separate claims.

37 CFR 1.83(a) requires that:

"The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box)."

Firstly, the Examiner has objected to the drawings claiming that the element "interface comprises an HTML page" of claim 13 is not shown in any of the drawings. FIGS. 4-7 depict a user interface for ordering and displaying content on-demand. Paragraph [0062] describes the user interface as provided by a conventional HTML page. Thus, it is submitted that FIGS. 4-7 meet the requirements of 37 CFR 1.83(a). Withdrawal/reversal of this objection is thus requested.

Secondly, the Examiner objects to the drawings as they allegedly do not illustrate that the "computing device comprises a personal digital assistant" or that "the computing device comprises a cellular telephone" as claimed in claims 21 and 22. The applicant notes that these limitations define species of the generic claim features and illustrated computing device 12 of FIG. 2 (see for example paragraph [0033]). As such, it is submitted that the depiction of the computing device 12 meets

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the requirement of 37 CFR 1.83 for the limitations of claims 21 and 22.
Withdrawal/reversal of the objection to the drawings is thus requested.

B. Rejecting claims 1-27 are being indefinite under 35 USC 112

The Examiner has rejected claims 1-27 pursuant to 35 USC 112 stating that the claims fail to particularly point out and distinctly claim the subject matter of the applicant's invention. The Examiner notes that the claims are "replete with errors" and then proceeds to identify only four specific examples that he considers indefinite. The applicant respectfully disagrees with the Examiner's rejection on the grounds of indefiniteness. Nevertheless, claims 2, 14 and 16 have been amended for clarity, and to put this case in better condition for appeal.

The Examiner rejects claim 1 noting that "it is unclear as to whom the 'remotely tuning' is performed". The applicant submits that this rejection is ill founded as the claim clearly recites "A method of providing content on-demand to a customer" and "remotely tuning one of said at least one tunable media receivers". Therefore, the applicant submits it is profoundly clear, and explicitly recited in the claim, that the tunable media receiver is being remotely tuned, so the claim meets the statutory requirement.

The rejection of the remaining claims appears completely baseless. Applicant does not even have an opportunity to address these rejections. The applicant further notes that such objections were not raised by the office in the first office action. Applicant requests the withdrawal/reversal of these rejections.

C. Rejecting claims 1-9, 11-32 as being anticipated by Mourad et al (US Patent No. 6,078,961 "Mourad")

The Examiner has rejected claims 1-9 and 11-32 as anticipated by Mourad et al. (US Patent No. 6,078,961 "Mourad") without making reference to any specific disclosure

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in Mourad to support this conclusion. The Examiner simply states "Mourad discloses the claimed invention including remotely tuning one of said at least one [sic] tunable media receivers over the cable television network".

The applicant submits that the Examiner's findings of anticipation are unsupported and clearly mistaken. *In re Makurkar Patent Litigation*, 28 USPQ2d 1801 at 1817 (N.D. Ill.), the court held that unless the prior art itself suggests the particular combination, it does not show that the actual invention is anticipated. The applicant submits that anticipation of claim 1-9, 11-32 has not been demonstrated because the Examiner has failed to identify where the particular elements or particular combination of the rejected claims are disclosed in the identified references.

Although, it is the applicant's submission that the Examiner has failed to meet his burden to establish anticipation, the applicant will present argument below to clearly illustrate the references identified by the Examiner do not properly anticipate any of the claims selected by the Examiner.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently. *Rapoport v. Dement*, 59 USPQ2d 1215 at 1218 (Fed. Cir. 2001). Further, the identical invention must be shown in as complete detail as is contained in the patent claim in order for a reference to properly anticipate a claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913 at 1920 (Fed. Cir. 1989)

Mourad discloses a method were a client work station can request content from a server which is then delivered downstream over a different network to the same client work station (Mourad; FIGS. 2 and 3).

a. CLAIM 1

As the client work station of Mourad requests a media stream, and displays the decoded media stream, Mourad does not disclose a media receiver and computing

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device that are separate, as claimed in claim 1 of the present application. Moreover, as a client workstation is used to view the media stream, Mourad does not disclose a tuneable media receiver. Similarly, Mourad does not disclose receiving an indicator of a customer identity from a computing device.

Further, as the architecture of Mourad is vastly different from the devices forming part of the claimed invention, Mourad does not simply does not "remotely tune" anything. Rather in Mourad the receipt of content is enabled by providing an indirection file indicating which port the requesting work station is to receive the multimedia file. (Mourad; Col 4: lines 19-23). Mourad provides content over the Internet, which employs no concept of tuning to channels but rather uses a packet addressing scheme. (Mourad; Col 4: lines 46-48).

As all of the limitations as claimed in claim 1 are not disclosed in Mourad at all, let alone in as complete detail as claimed as required, Mourad simply does not properly anticipate claim 1.

Reversal of the rejection of claim 1 under 35 USC 102 in view of Mourad is requested.

b. CLAIMS 2-9 AND 10-26

It is further submitted that Mourad does not anticipate dependent claims 2-9 and 11-26, as additional limitations contained in these claims are not disclosed by Mourad. Example deficiencies of Mourad are set out below:

CLAIM 2

Mourad fails to disclose the additional limitation of receiving an indicator over the data network of a particular one of the at least one media receivers, chosen by the customer for receipt of the content, and wherein the tuning comprises tuning that particular one of the at least one receivers, as claimed in claim 2.

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Withdrawal/reversal of the rejection of claim 2 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 3

Mourad similarly fails to disclose determining a distribution node on the cable network in communication with the media receiver, as claimed in claim 3.

Withdrawal/reversal of the rejection of claim 3 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 5

Mourad similarly additionally fails to disclose that the tuned channel is identified by a radio frequency channel, and an identifier of a stream carrying the content within the channel, as claimed in claim 5.

Withdrawal/reversal of the rejection of claim 5 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 7

Mourad similarly additionally fails to disclose further verifying availability of sufficient bandwidth from the distribution node to the customer to deliver the content, prior to tuning the receiver, as claimed in claim 7.

Withdrawal/reversal of the rejection of claim 7 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 8

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Mourad similarly additionally fails to disclose maintaining a database storing an identifier of the customer and an identifier of an associated distribution node, as claimed in claim 8.

Withdrawal/reversal of the rejection of claim 8 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 9

Mourad similarly additionally fails to disclose further comprising maintaining an indicator of available bandwidth for delivery of content on-demand from the distribution node, in the database, as claimed in claim 9.

Withdrawal/reversal of the rejection of claim 9 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 11

Mourad similarly additionally fails to disclose a user interface presented as a result of a Java applet or ASP, presented to the claimed computing device, as claimed in claim 11.

Withdrawal/reversal of the rejection of claim 11 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 12

Mourad similarly additionally fails to disclose further comprising providing preview data for the available content by way of the data network, as claimed in claim 12.

Withdrawal/reversal of the rejection of claim 12 under 35 USC 102 in view of Mourad is therefore requested.

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CLAIM 17

Mourad similarly additionally fails to disclose further comprising providing the claimed computing device with information regarding playing of in-progress content, for display at the computing device, as claimed in claim 17.

Withdrawal/reversal of the rejection of claim 17 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 19

Mourad similarly additionally fails to disclose further comprising maintaining an expiry time for the content, and preventing presentation of content after the expiry time, as claimed in claim 19.

Withdrawal/reversal of the rejection of claim 19 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 20

Mourad similarly additionally fails to disclose further comprising maintaining a maximum playing time for the content, and preventing presentation after the content has been presented for a time in excess of the maximum playing time, as claimed in claim 20.

Withdrawal/reversal of the rejection of claim 20 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 21

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Mourad similarly additionally fails to disclose wherein the computing device comprises a personal digital assistant, as claimed in claim 21.

Withdrawal/reversal of the rejection of claim 21 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 22

Mourad similarly additionally fails to disclose wherein the computing device comprises a cellular phone, as claimed in claim 22.

Withdrawal/reversal of the rejection of claim 22 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 24

Mourad similarly additionally fails to disclose wherein provision of the content may be stopped at one media receiver and resumed at another media receiver, as claimed in claim 24.

Withdrawal/reversal of the rejection of claim 24 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 25

Mourad similarly additionally fails to disclose wherein the user interface present available content based on its rating and an access level associated with the customer, as claimed in claim 25.

Withdrawal/reversal of the rejection of claim 25 under 35 USC 102 in view of Mourad is therefore requested.

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CLAIM 26

Mourad similarly additionally fails to disclose computer readable medium storing computer executable instructions, that when loaded at a content on-demand delivery system including at least one processor, adapts the delivery system to perform the method of claim 1, as claimed in claim 26.

Withdrawal/reversal of the rejection of claim 26 under 35 USC 102 in view of Mourad is therefore requested.

c. CLAIM 27

Claim 27 is an independent claim claiming a system having functionality for providing content-on-demand in much the same way as claimed in claim 1. Consequently, for the reasons set out above, Mourad similarly fails to disclose a system including the claimed combination of elements, to provide the functionality as claimed.

Withdrawal/reversal of the rejection of independent claim 27 is therefore requested.

d. CLAIM 28

Claim 28 is an independent claim similar to claim 1, and is thus not anticipated by Mourad for the reasons set out above. Claim 28, further clarifies that the data network is a packet switched network, and that a tuneable receiver is identified prior to remotely tuning. These limitations are similarly absent from the disclosure of Mourad.

Withdrawal/reversal of the rejection of claim 28 under 35 USC 102 in view of Mourad is therefore requested.

e. CLAIMS 29-32

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It is further submitted that Mourad does not anticipate dependent claims 29-32 dependent directly or indirectly on Claim 28, as additional limitations contained in these claims are not disclosed by Mourad. Example deficiencies of Mourad are set out below:

CLAIM 29

Mourad fails to disclose the additional limitation of determining a distribution node on the cable television network in communication with the media receiver, and narrowcasting the content by way of the distribution node, as claimed in claim 29.

Withdrawal/reversal of the rejection of claim 29 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 30

Likewise, Mourad fails to disclose further comprising maintaining an indicator of available bandwidth for delivery of content on-demand from the distribution node and verifying availability of sufficient bandwidth from the distribution node to the customer to deliver the content prior to the tuning, as claimed in claim 30.

Withdrawal/reversal of the rejection of claim 30 under 35 USC 102 in view of Mourad is therefore requested.

CLAIM 31

Mourad also fails to disclose comprising updating the indicator of available bandwidth to reflect the providing of the content, as claimed in claim 31.

Withdrawal/reversal of the rejection of claim 30 under 35 USC 102 in view of Mourad is therefore requested.

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Based on the foregoing, the applicant believes to have demonstrated that Mourad does not anticipate any of the claims and therefore requests that the Examiner's rejection under 35 USC 102 in view of Mourad be reversed.

D. Rejecting claims 1-9, 11-32 as being anticipated by Handelman (US Patent No. 5,716,315 "Handelman")

The Examiner takes the position that claims 1-9 and 11-32 are anticipated by Handelman. Again, the Examiner provides no basis for such a rejection. The applicant submits that Handelman does not anticipate the claimed invention, as there are multiple limitations in claims 1 and seq. that are not disclosed by Handelman.

a. CLAIM 1

Fundamentally, Handelman does not appear to disclose a method of delivering content on demand on a remotely tuned channel. More specifically, Handelman does not disclose a computing device separate from a media receiver; nor receiving anything over a data network; nor remotely tuning a tunable media receiver to receive content on-demand; nor of providing the content for receipt by the channel that has been remotely tuned, as claimed in claim 1. At best, Handelman discloses a CATV interface including a processor and a tuner (see FIG. 2) and suggests the possibility of allowing the receipt of addressed encrypted content after authorization (see. column 6, lines 52-58).

Consequently, the applicant submits that as all the claim limitations are not disclosed in Handelman, claim 1 is simply not anticipated and requests the Examiner's rejection be reversed.

b. CLAIMS 2-9 AND 10-26

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b. CLAIMS 2-9 AND 10-26

Handelman simply also does not disclose the individual additional limitations identified in dependent claims 2-26. Example deficiencies of Handelman are set out below:

CLAIM 2

Handelman additionally fails to disclose receiving an indicator over the data network of a particular one of the at least one media receivers, chosen by the customer for receipt of the content, and wherein the tuning comprises tuning that particular one of the at least one receivers, as claimed in claim 2.

Withdrawal/reversal of the rejection of claim 2 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 3

Handelman similarly fails to disclose determining a distribution node on the cable network in communication with the media receiver, as claimed in claim 3.

Withdrawal/reversal of the rejection of claim 3 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 4

Handelman similarly fails to disclose presenting to the customer an interface for selecting the content over the data network, from a selection of available content, as claimed in claim 4.

Withdrawal/reversal of the rejection of claim 3 under 35 USC 102 in view of Handelman is therefore requested.

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CLAIM 5

Handelman similarly additionally fails to disclose that the tuned channel is identified by a radio frequency channel, and an identifier of a stream carrying the content within the channel, as claimed in claim 5.

Withdrawal/reversal of the rejection of claim 5 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 7

Handelman similarly additionally fails to disclose further comprising verifying availability of sufficient bandwidth from the distribution node to the customer to deliver the content, prior to the tuning, as claimed in claim 7.

Withdrawal/reversal of the rejection of claim 7 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 8

Handelman similarly additionally fails to disclose further comprising maintaining a database storing an identifier of the customer and an identifier of an associated distribution node, as claimed in claim 8.

Withdrawal/reversal of the rejection of claim 3 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 9

Handelman similarly additionally fails to disclose further comprising maintaining an indicator of available bandwidth for delivery of content on-demand from the

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distribution node in the database, as claimed in claim 9.

Withdrawal/reversal of the rejection of claim 9 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 10

Handelman similarly additionally fails to disclose updating the indicator of available bandwidth to reflect the providing of the content, as claimed in claim 10.

Withdrawal/reversal of the rejection of claim 10 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 11

Handelman similarly additionally fails to disclose a user interface presented as a result of a Java applet or ASP, presented to the computing device, as claimed in claim 11.

Withdrawal/reversal of the rejection of claim 11 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 12

Handelman similarly additionally fails to disclose further comprising providing preview data for the available content by way of the data network, as claimed in claim 12.

Withdrawal/reversal of the rejection of claim 3 under 35 USC 102 in view of Handelman is therefore requested.

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CLAIM 13

Handelman similarly additionally fails to disclose wherein the interface comprises an HTML page, as claimed in claim 13.

Withdrawal/reversal of the rejection of claim 13 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 14

Handelman similarly additionally fails to disclose further comprising receiving commands controlling provision of an in progress content by way of the data network, and in response thereto controlling the provision of the in-progress content, substantially in real time, as claimed in claim 14.

Withdrawal/reversal of the rejection of claim 14 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 15

Handelman similarly additionally fails to disclose wherein the commands include one or more commands to pause, advance or rewind the in-progress content, , as claimed in claim 15.

Withdrawal/reversal of the rejection of claim 15 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 16

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Handelman similarly additionally fails to disclose wherein the providing comprises instructing a media server to stream the content over the cable television network, as claimed in claim 16.

Withdrawal/reversal of the rejection of claim 16 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 17

Handelman similarly additionally fails to disclose further comprising providing the computing device with information regarding playing of in-progress content, for display at the computing device, as claimed in claim 17.

Withdrawal/reversal of the rejection of claim 3 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 18

Handelman similarly additionally fails to disclose wherein the information regarding playing includes an indicator of elapsed time, as claimed in claim 18.

Withdrawal/reversal of the rejection of claim 3 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 19

Handelman similarly additionally fails to disclose further comprising maintaining an expiry time for the content, and preventing presentation of the content after the expiry time, as claimed in claim 19.

Withdrawal/reversal of the rejection of claim 19 under 35 USC 102 in view of Handelman is therefore requested.

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CLAIM 20

Handelman similarly additionally fails to disclose further comprising maintaining a maximum playing time for the content, and preventing presentation after the content has been presented for a time in excess of the maximum playing time, as claimed in claim 20.

Withdrawal/reversal of the rejection of claim 20 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 21

Handelman similarly additionally fails to disclose wherein the computing device comprises a personal digital assistant, as claimed in claim 21.

Withdrawal/reversal of the rejection of claim 21 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 22

Handelman similarly additionally fails to disclose wherein the computing device comprises a cellular phone, as claimed in claim 22.

Withdrawal/reversal of the rejection of claim 22 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 23

Handelman similarly additionally fails to disclose wherein the computing device comprises a personal computer, as claimed in claim 23.

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CLAIM 24

Handelman similarly additionally fails to disclose wherein provision of the content may be stopped at one media receiver and resumed at another media receiver, as claimed in claim 24.

Withdrawal/reversal of the rejection of claim 24 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 25

Handelman similarly additionally fails to disclose wherein the user interface present available content based on its rating and an access level associated with the customer, as claimed in claim 25.

Withdrawal/reversal of the rejection of claim 25 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 26

Handelman similarly additionally fails to disclose computer readable medium storing computer executable, that when loaded at a content on-demand delivery system including at least one processor, adapts the delivery system to perform the method of claim 1, as claimed in claim 26.

c. CLAIM 27

Claim 27 is an independent claim claiming a system having functionality for providing content-on-demand in much the same way as claimed in claim 1. Consequently, for the reasons set out above, Handelman similarly fails to disclose a system including the claimed combination of elements to provide the functionality as claimed.

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Withdrawal/reversal of the rejection of independent claim 27 is therefore requested.

d. CLAIM 28

Claim 28 is an independent claim similar to claim 1 and is thus not anticipated by Handelman for the reasons set out above. Claim 28 further clarifies that the data network is a packet switched network and that a tuneable receiver is identified prior to remotely tuning. These limitations are similarly absent from the disclosure of Handelman.

Withdrawal/reversal of the rejection of claim 28 under 35 USC 102 in view of Handelman is therefore requested.

e. CLAIMS 29-32

It is further submitted that Handelman does not anticipate dependent claims 29-32 dependent directly or indirectly on Claim 28, as additional limitations contained in these claims are not disclosed by Handelman. Example deficiencies of Handelman are set out below:

CLAIM 29

Handelman fails to disclose the additional limitation of determining a distribution node on the cable television network in communication with the media receiver, and narrowcasting the content by way of the distribution node, as claimed in claim 29.

Withdrawal/reversal of the rejection of claim 29 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 30

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CLAIM 30

Likewise, Handelman fails to disclose further comprising maintaining an indicator of available bandwidth for delivery of content on-demand from the distribution node and verifying availability of sufficient bandwidth from the distribution node to the customer to deliver the content prior to the tuning, as claimed in claim 30.

Withdrawal/reversal of the rejection of claim 30 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 31

Handelman also fails to disclose comprising updating the indicator of available bandwidth to reflect the providing of the content, as claimed in claim 31.

Withdrawal/reversal of the rejection of claim 30 under 35 USC 102 in view of Handelman is therefore requested.

CLAIM 32

Handelman also fails to disclose further providing a user interface at the computing device to control delivery of the content; receiving commands controlling provision of in progress content by way of the data network; and in response thereto controlling the provision of the in-progress content, substantially in real time, as claimed in claim 32.

Withdrawal/reversal of the rejection of claim 32 under 35 USC 102 in view of Handelman is therefore requested.

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**E. Rejecting claims 1-9, 11-32 as being obvious under 35 USC 103(a)
over Mourad in view of Baker et al. (US Patent No. 5,583,561)**

The Examiner rejects claims 1-9 and 11-32 as being obvious over Mourad in view of Baker et al. (US Patent No. 5,583,561). Although the Examiner asserts that the claims are anticipated by Mourad, the Examiner alternatively asserts that the claims are obvious in view of Mourad and Baker.

Although baldly identifying Mourad as anticipating the claims under 35 USC 102, in this obviousness rejection the Examiner seems to suggest that some elements of the claimed invention may be inherent in the embodiments disclosed by Mourad. The Examiner assert that a person of ordinary skill would include "the generic elements of a cable television system" to help lower the cost of selective retrieval and distribution of digital video.

The applicant respectfully disagrees and requests that the Examiner's rejection be reversed. The applicant fails to appreciate the relevance of the Examiner's comments and how this would render the claimed invention obvious as neither the generic elements of a cable distribution system or a method to lower the cost of selective retrieval and distribution of content are claimed. Rather a novel method including the step of remotely tuning a media receiving separate from a computing device used to initiate the receipt of content through the provisioning of an indicator of customer identity and a request for specific content, is claimed. This is not disclosed nor suggested by Mourad or Baker.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143 (rev. Feb. 2003), *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

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to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143 (rev. Feb. 2003), *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

The applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness as no suggestion or motivation to make the claimed combination has been identified. In order to establish a finding of obviousness the prior art references must suggest the desirability of the claimed combination. *In re Mills*, 16 USPQ2d 1430 at 1423 (Fed. Cir. 1990). The applicant submits that the Examiner has failed to identify any suggestion to combine the references in the manner claimed would be desirable. Thus, the applicant submits that the Examiner has not established a *prima facie* case of obviousness.

In order to render a combination obvious, the prior art itself must suggest the particular combination. *In re Mahurkar Patent Litigation*, 28 USPQ2d 1801 at 1817 (Fed. Cir. 1993). Furthermore, all the claim limitations must be taught or suggested in the prior art to establish a *prima facie* case of obviousness. *In re Royka*, 180 USPQ 580 at 582 (CCPA 1974), MPEP § 2143.03 (rev. Feb. 2003). It is submitted that there is no suggestion or motivation in the prior art that it would be desirable to combine the references in the particular combination claimed, accounting for all claim limitations. Thus, the Examiner's rejection should be reversed.

A detailed explanation of claim elements not disclosed by Mourad is found above. Baker similarly fails to disclose remotely tuning a media receiver to a channel not otherwise receivable. Baker instead discloses a system that employs multi-casting and synchronization groups to deliver the on demand content to the subscriber. There is no explicit disclosure of providing the content on-demand through remotely tuning to a channel not otherwise receivable by the subscriber. Rather the disclosure of multi-casting and synchronization groups would suggest to one skilled in the art an address based system such as the ATM protocol to deliver the content. In this system, the different synchronization groups for the same content would most likely

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motivation as to the desirability of a system or method as claimed where the subscriber media receiver is remotely tuned to a channel not otherwise receivable.

The references also provide no suggestion as to the desirability of such a combination as required to establish a *prima facie* case of obviousness. The inventor and only the inventor has recognized the desirability of initiating a request for content from a separate computing device and remotely tuning a media receiver in response to the receipt of an indicator identifying the customer and media stream request provided from the computing device. This may increase the likelihood of customers placing orders for on demand content because of the reduction in the need for special purpose hardware and reducing the need for such hardware to be upgraded in the future.

As such, a conventional set top box may be used to provide on-demand content rather than employing a special purpose device which would require a hardware upgrade at the subscriber premises. There is no motivation in the prior art to suggest that such a system is desirable and consequently the applicant submits that claim 1 is not obvious.

Elements of dependent claims 2-9 and 11-26 are similarly missing from the disclosure of Mourad, as detailed above. Baker similarly does not disclose or provide a motivation to include missing elements of the dependent claims to arrive at any of the claims. Reversal of the rejections of claims 2-9 and 11-26 under 35 USC 103 in view of Mourad and Baker is therefore requested.

The applicant submits that the Examiner's rejection of claim 27 be reversed for similar reasons as claim 1. Additionally, no suggestion or motivation is provided in the prior art to use a controller in connection with a server receiving requests from a computing device separate from a media receiver that is remotely tuned by the controller to a channel not otherwise tunable by the requesting customer.

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computing device separate from a media receiver that is remotely tuned by the controller to a channel not otherwise tunable by the requesting customer.

Regarding claim 28, the applicants submits this claim is not obvious for substantially the same reasons as presented in relation to claim 1. Also, the references provide no suggestion or motivation or teaching that it would be desirable to construct a system allowing the presentation of available on demand content to the separate computing device. Additionally, there is no disclosure of a method of remotely tuning a media receiver separate from the computer device to a channel not otherwise tunable in response to the receipt of an indicator of customer identity and media request from the separate computing device. Baker instead discloses a decoder that appears to use an addressing scheme and Mourad is of little relevance.

Dependant claims 29-32 are submitted not to be obvious on the same grounds as claim 28.

Based on the foregoing, the applicant submits that claims 1-9 and 11-32 are not obvious and the reversal of the Examiner's rejection under 35 USC 103 in view of Mourad and Baker is respectfully requested.

F. Rejecting claim 10 as being obvious under 35 USC 103(a) as being obvious over Mourad in view of Geile et al. (US Patent No. 6,279,158)

The Examiner has rejected claim 10 as being obvious over Mourad in view of Geile et al. (US Patent No. 6,279,158). The Examiner claims that although Mourad does not teach bandwidth manipulation Geile teaches indicators of bandwidth manipulation and therefore it would have been obvious to one of ordinary skill in the art to modify Mourad to include indicators of bandwidth allocation. The Examiner fails to reference any specific disclosure in either reference to support this conclusion.

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taught or suggested in the prior art to establish a *prima facie* case of obviousness. *In re Royka*, 180 USPQ 580 at 582 (CCPA 1974), MPEP § 2143.03 (rev. Feb. 2003).

Claim 10 is a dependent claim which includes the limitations in claims 1, 3, 8 and 9 in addition to the limitations introduced in claim 10 itself. The applicant submits the Examiner has failed to establish a *prima facie* case of obviousness as all the claim limitations are not suggested in the prior art as required to properly render the claim obvious [see discussion re rejection of claims 1, 3, 8 and 9 under 35 USC 102 in view of Mourad, *supra*].

Put quite simply: Geile appears to be directed generally to communications systems, and generally to multi-carrier transport. Based on the Examiner's rejection it is unclear how, or why the teachings of Geile could or might be incorporated into the disclosure of Mourad to arrive at the claimed invention of claim 10. Reversal of the rejection of claim 10 under 35 USC 103 in view of Mourad and Geile is thus requested.

For all the foregoing reasons the applicant submits that a *prima facie* case of obviousness has not been established and further that claim 10 is not obvious. Thus, the reversal of the Examiner's rejection is respectfully requested.

Summary

For all of the above reasons, it is submitted that the Examiner's objection to the drawings; the rejections of claims 1-27 as indefinite; and the rejections of claims 1-32 are improper. Reversal of these objections/rejections is respectfully requested.

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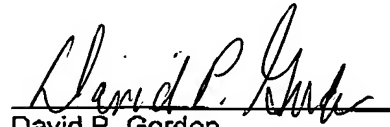
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Appendix A – Claims Currently on File

1. A method of providing content on-demand to a customer having at least one tunable media receiver interconnected with a cable television network, and a computing device separate from said media receiver and in communication with a data network, said method comprising:

receiving from said computing device over said data network, an indicator of an identity of said customer and a request for a media stream;

remotely tuning one of said at least one tunable media receivers over said cable television network, to receive said content over said cable television network on a tuned channel that is not otherwise tunable by said customer;

providing said content over said cable television network for receipt and presentation by said media receiver, when tuned to said tuned channel.

2. The method of claim 1, further comprising receiving an indicator of a particular one of said at least one media receivers, chosen by said customer for receipt of said content over said data network, and wherein said tuning comprises tuning said particular one of said at least one receivers.

3. The method of claim 1, further comprising

determining a distribution node on said cable network in communication with said media receiver.

4. The method of claim 1, further comprising presenting to said customer an interface for selecting said content over said data network, from a selection of available content.

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5. The method of claim 1, wherein said tuned channel is identified by a radio frequency channel, and an identifier of a stream carrying said content within said channel.
6. The method of claim 5, wherein said content comprises a video stream.
7. The method of claim 3, further comprising verifying availability of sufficient bandwidth from said distribution node to said customer to deliver said content, prior to said tuning.
8. The method of claim 3, further comprising maintaining a database storing an identifier of said customer and an identifier of an associated distribution node.
9. The method of claim 8, further comprising maintaining an indicator of available bandwidth for delivery of content on-demand from said distribution node in said database.
10. The method of claim 9, further comprising updating said indicator of available bandwidth to reflect said providing of said content.
11. The method of claim 4, wherein said user interface is presented as a result of a Java applet or ASP, presented to said computing device.
12. The method of claim 4, further comprising providing preview data for said available content by way of said data network.
13. The method of claim 4, wherein said interface comprises an HTML page.
14. The method of claim 1, further comprising receiving commands controlling provision of an in progress content by way of said data network, and in response

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to said receiving commands controlling provision of an in-progress content, controlling said provision of said in-progress content, substantially in real time.

15. The method of claim 14, wherein said commands include one or more commands to pause, advance or rewind said in-progress content.

16. The method of claim 1, wherein said providing comprises instructing a media server to stream said content over said cable television network.

17. The method of claim 1, further comprising providing said computing device with information regarding playing of in-progress content, for display at said computing device.

18. The method of claim 17, wherein said information regarding playing includes an indicator of elapsed time.

19. The method of claim 1, further comprising maintaining an expiry time for said content, and preventing presentation of said content after said expiry time.

20. The method of claim 19, further comprising maintaining a maximum playing time for said content, and preventing presentation after said content has been presented for a time in excess of said maximum playing time.

21. The method of claim 1, wherein said computing device comprises a personal digital assistant.

22. The method of claim 1, wherein said computing device comprises a cellular phone.

23. The method of claim 1, wherein said computing device comprises a personal computer.

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24. The method of claim 14, wherein provision of said content may be stopped at one media receiver and resumed at another media receiver.

25. The method of claim 4, wherein said user interface present available content based on its rating and an access level associated with said customer.

26. Computer readable medium storing computer executable instructions, that when loaded at content on-demand delivery system including at least one processor, adapt said delivery system to perform the method of claim 1.

27. A system for providing content on-demand to a customer having at least one tunable media receiver interconnected with a cable television network, and a computing device separate from said media receiver and in communication with a data network, said method comprising:

- a server for receiving from said computing device over said data network, an indicator of an identity of said customer and a request for a media stream;
- a controller in communication with said server for remotely tuning one of said at least one tunable media receivers over said cable television network, to receive said content over said cable television network on a tuned channel that is not otherwise tunable by said customer;
- a media server in communication with said server providing said content over said cable television network for receipt and presentation by said media receiver, when tuned to said tuned channel.

28. A method of providing content on-demand by way of a cable television network to a customer having a computing device in communication with a packet switched data network, said method comprising:

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presenting a selection of available content on demand at said computing device by way of said packet switched data network;
receiving from said computing device over said packet switched data network, an indicator of an identity of said customer and a request for a media stream;
identifying at least one tunable media receiver interconnected with a cable television network, based on said indicator;
remotely tuning one of said at least one tunable media receiver over said cable television network, to receive said media stream over said cable television network on a tuned channel that is not otherwise tunable by said customer;
providing said media stream over said cable television network for receipt and presentation by said media receiver, when tuned to said tuned channel.

29. The method of claim 28, further comprising

determining a distribution node on said cable television network in communication with said media receiver, and narrowcasting said content by way of said distribution node.

30. The method of claim 29, further comprising maintaining an indicator of available bandwidth for delivery of content on-demand from said distribution node and verifying availability of sufficient bandwidth from said distribution node to said customer to deliver said content prior to said tuning.

31. The method of claim 30, further comprising updating said indicator of available bandwidth to reflect said providing of said content.

32. The method of claim 30, further comprising providing a user interface at said computing device to control delivery of said content; receiving commands

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controlling provision of in progress content by way of said data network; and in response thereto controlling said provision of said in-progress content, substantially in real time.

33. A method allowing a customer to receive content on demand, provided by way of a cable television network, comprising:

contacting through a computing device, a server by way of a data network;
obtaining from said server a list of available content on demand offerings;
placing an order for a content on demand offering by way of said data network, including an identifier of said customer;
receiving a tuning command at a media receiver associated with said customer and separate from said computing device, over said cable television network;
receiving a narrowcast media stream at said media receiver;
decoding said narrowcast media stream at said media receiver;
presenting said content on demand to said subscriber by way of said media receiver.

34. The method of claim 33, wherein said data network comprises the internet.

35. The method of claim 34, wherein said list is provided by way of a world-wide web page.

36. The method of claim 35, wherein said world-wide web page further provides access to previews of said content-on demand, by way of said data network.

37. The method of claim 33, further comprising presenting information regarding playing of in-progress content on demand, at said computing device.

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38. The method of claim 35, further comprising providing a user interface at said computing device to allow control of provision of in progress content on demand at said media receiver, by way of said data network, substantially in real time.